

PATENT
Application # 09/945,350
Attorney Docket # 2005P12937US (1009-236)

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

The Examiner is also thanked for determining claim 64 allowable.

Each of claims 32, 47, 49, 50, 62, 63, 65, 66, 67, and 71 has been amended for at least one reason unrelated to patentability, including at least one of: to address an informality; to correct a typographical error; to explicitly present one or more limitations, phrases, words, terms, and/or elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Each of claims 1, 2, 4-6, 8-31, 40 and 48 was withdrawn without traverse.

Claims 32, 33, 35, 36, 38, 39, 41-47, and 49-71 are now pending in this application.

Each of claims 32, 47, 49, 50, 64, 66, 67, and 71 are in independent form.

I. The Restriction Requirement

In response to paragraph 3 of the Office Action, Group II, claims 32, 33, 35, 36, 38, 39, 41-47, and 49-71 are elected without traverse.

II. The Objection to Claim 84

Claim 84 was objected to for an improper status identifier. Claim 84 has been amended to correct the status identifier. Therefore, Applicant respectfully submits that any grounds for this objection has been removed, and respectfully requests acknowledgment thereof.

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III. The Obviousness Rejections

Each of claims 32, 33, 35, 36, 38, 39, 41-47, 49-63, and 65-71 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of U.S. Patent No. 5,857,190 ("Brown"), U.S. Patent No. 6,918,131 ("Rautila"), U.S. Patent No. 6,038,601 ("Lambert"), U.S. Patent No. 6,698,020 (Zigmond), and/or U.S. Patent No. 6,469,753 ("Klosterman"). Each of these rejections is respectfully traversed.

A. Claims 50-63, 65-71

The rejection of each of claims 50-63, 65-71 is respectfully traversed as moot in light of amendments to at least each of independent claims 50, 66, 67, and 71. Specifically, like allowed claim 64, each of claims 50-63, 65-71 state, yet none of the applied portions of the relied upon references teach, "the distinct digital content selected for presentation in a manner so as to minimize interest in the identified" "viewers in continuing to view the presentation of digital content."

B. Claims 32, 33, 35, 36, 38, 39, 41-47, and 49

Over 40 years ago, in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. Those factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

The Federal Circuit has applied *Graham*'s required factual inquiry in numerous legal precedents that are binding on the USPTO.

It is recognized that most patentable inventions arise from a combination of old elements and often, each element is found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The United States Supreme Court clarified the obviousness inquiry criteria in *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). The KSR Court held:

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1. “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”;
2. “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”;
3. it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit”; and
4. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

In order to establish a *prima facie* case of obviousness, certain criteria must be met.

Evidence must be provided that indicates that the combination was obvious to a person with ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The evidence must include an apparent reason, with a rational underpinning, to combine the known elements in the fashion claimed in the patent at issue. *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007). There must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143. In addition, the prior art reference (or references when combined) must teach... all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP 2143.

Moreover, the “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

To factually support a *prima facie* conclusion of obviousness, an Office Action must provide evidence that indicates that the combination was obvious to a person with ordinary skill in the art. The evidence must include an apparent reason, with a rational underpinning, to

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combine the known elements in the fashion claimed in the patent at issue. "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" *KSR International Co. v. Teleflex Inc.*, 2007 U.S. LEXIS 4745 (2007) (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006).

It is legal error to "substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results." *See, In re Ochiai*, 71 F.3d 1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, 'the burden of coming forward with evidence or argument shifts to the applicant.'" *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

The rejection of each of claims 32, 33, 35, 36, 38, 39, 41-47, and 49 is respectfully traversed as moot in light of amendments to at least each of independent claims 32, 47, and 49. Specifically, each of claims 32, 33, 35, 36, 38, 39, 41-47, and 49 state, yet none of the applied portions of the relied upon references teach, "in response to an interaction with the one remote computing device by one or more viewers of a corresponding content presentation device associated with the one remote computing device".

Moreover, the present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Brown and Lambert no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claims 32, 33, 35, 36, 38, 39, 41-47, and 49, in such a manner so as to arrive at the claimed subject matter of these claims.

Regarding the proffered combination of Brown and Lambert the present Office Action states, at Page 6:

"It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Brown to include polling a subscriber for status

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information when no event messages have arrived from said subscriber after a predetermined period of time, as taught by Lambert, for the benefit of improved usage statistics gathering, as knowledge of the operability of a subscriber device is highly relevant to a system attempting to track the usage habits of subscribers."

Applicant respectfully submits that this unsupported assertion provides no evidence of, from the perspective of one of ordinary skill in the art, a "rational underpinning, to combine the known elements in the fashion claimed in the patent at issue". Moreover, no evidence is presented that this unsupported assertion, or even the alleged benefit, was "known in the prior art", as required by KSR. Applicant reiterates that under KSR "rejections on obviousness grounds cannot be sustained by mere conclusory statements".

For at least these reasons, reconsideration and withdrawal of each rejection of claims 32, 33, 35, 36, 38, 39, 41-47, 49-63, and 65-71 is respectfully requested.

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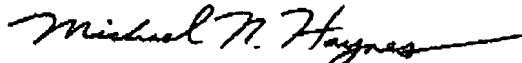
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

Michael Haynes PLC



Michael N. Haynes

Registration No. 40,014

Date: 09 August 2007

1341 Huntersfield Close

Keswick, VA 22947

Telephone: 434-972-9988

Facsimile: 815-550-8850